

Appl. No. 10/136,001

Reply to Office Action of 11/30/2005

Attorney Docket No. : 6045-006

DRAFT**Remarks/Arguments:**

In the Office Action dated November 30, 2005 the Examiner rejected claim 13 under 35 U.S.C. 112(b) second paragraph as being indefinite, rejected claims 9, 10, 12-14, and 16-18 under 35 U.S.C. 102(b) as being anticipated by Snedeker Patent 774,994, rejected claims 9, 10, 12, 13, and 16-18 under 35 U.S.C. 102(b) as being anticipated by the Rennie Patent No. 191,368 rejected claim 15 under 35 U.S.C. 103(a) as being unpatentable over Snedeker and over Rennie in view of Brownell Patent 6,234,549. No other basis of rejection was stated of record.

Background of the Law

The standard for indefiniteness has been set fairly high. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001). A claim is not indefinite merely because its scope is not ascertainable from the face of the claims; rather, it is indefinite if it is insolubly ambiguous. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342, 65 USPQ2d 1385, 1406 (Fed. Cir. 2003). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Allen Eng'g v. Bartell Indus.*, 299 F.3d 1336, 1350, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002), see e.g. MPEP §2173.02.

In order to establish a proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements must either be inherent or disclosed expressly in the single prior art reference. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB. v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986).

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; and there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d

Appl. No. 10/136,001
Reply to Office Action of 11/30/2005
Attorney Docket No. : 6045-006

DRAFT

1781, 1785 (Fed. Cir. 2002). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, *or*, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim". *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

Obviousness under 35 U.S.C. §103 is a question of law based on findings of underlying facts relating to the prior art, the skill of the artisan, and objective considerations. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467, 15 L.Ed. 2d 545, 86 S.Ct. 684 (1966). To establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation in the prior art to make the specific combination or modification suggested by the Examiner. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPPQ2d 1630, 1631 (Fed. Cir. 1993). Obviousness cannot be established by hindsight combination or modification to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991).

Summary of Amendments

Applicant has amended Claims 12, 16, and 17 according to Examiner's suggestions to overcome Examiner's objections. Applicant has amended Claim 9 to more clearly state and define subject matter regarded as the invention. Applicant has amended Claim 13 to more particularly point out and distinctly claim subject matter regarded as the invention. Applicant respectfully submits that the newly submitted Claims define patentable subject matter over the prior art cited and of record in this application.

Claim 13 is not Indefinite when considering the content of the application's disclosure

Applicant has amended Claim 13 to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Claim 13 now reads that the terminating edge of the arcuate handle terminates *proximately to the top portion* of each of the first and

Appl. No. 10/136,001

Reply to Office Action of 11/30/2005

Attorney Docket No. : 6045-006

DRAFT

second lateral side walls. Figure 4 clearly shows that the terminating edge of the arcuate handle terminates near the top portion of the side walls.

Moreover, the exact meaning of the recited phrase “the terminating end edge of the arcuate handle is generally forwardly facing toward the open end of the planar base” is clearly understood with reference to previous claims, the figures 3 & 4, and the detailed description. Claim 9 indicates that the culinary utensil has an open end which is the forward facing portion of the device, as shown by the language “rearwardly extending projection...being curved upwardly from the planar base and generally *forwardly toward the open end* in an arcuate manner”. Figure 3 shows that the terminating end edge of the arcuate handle is generally forwardly facing toward the open end of the device, with reference to Figure 4 which shows that the terminating end edge is pointing towards the open end. And finally, the detailed description states that “open end” is used to mean the end of the flat base that has no physical barrier barring access onto the flat base and also means the opposite side of the flat base from the “closed end”. (¶0016, lines 22-24). Therefore, by the content of the disclosure, claim 13 apprises one of ordinary skill in the art to ascertain the scope of the claim and to properly serve the notice function as required by 35 U.S.C. 112 second paragraph.

The Snedeker Reference does not Anticipate a Handleless Culinary Utensil Holding Food Objects and Limiting Spillage, or Having a Terminating Edge Generally Forward Facing, or Having a Terminating Edge Generally Rearwardly Facing

With regard to Claim 9, the Snedeker reference does not anticipate a *handleless culinary utensil holding food objects and limiting spillage*. The preamble of claim 9 has been amended to state that the device is a “handleless culinary utensil holding food objects and limiting spillage”. “Handleless” is defined by the specification as device that lacks protruding handle used to grip the device. ¶0010, lines 25-26. Handleless limits the structure of the claimed invention by requiring that the culinary utensil to lack a protruding handle; therefore, handleless must be treated as a claim limitation. Furthermore, a handleless culinary utensil for holding food objects and limiting spillage is necessary to give life, meaning, and vitality to the claim, because the present invention is used for transporting food objects efficiently and good maneuverability around a kitchen area by virtue of a lack of protruding parts. ¶0008. (“Utensil” is a “container

Appl. No. 10/136,001
Reply to Office Action of 11/30/2005
Attorney Docket No. : 6045-006

DRAFT

used domestically, especially in the kitchen”, see Merriam-Webster Dictionary at www.dictionary.com). Additionally, the Snedeker reference could not be used a handleless culinary utensil for holding food objects and limiting spillage due to the fact the Snedeker reference discloses a dust pan, which is mounted on protruding handle 7 as to cause the dust pan to automatically assume a position to receive dust when placed upon the floor. Col 1, lines 22-25. Furthermore, the arcuate flange 5a in the Snedeker reference could not operate as an arcuate handle as in Claim 9 due to the interference of the bail 9, which connects to handle 7 and pivots on the opposite sides of the pan. Col. 2, lines 94-96.

With regard to Claim 13, Figure 4 of the Snedeker reference does not teach or show that the terminating edge of the arcuate handle is *generally forwardly facing* toward the open end of the planar base. Clearly from Figure 4, the terminating edge is substantially facing *upwardly*, and Claim 13 has the limitation of the terminating edge of the arcuate handle generally forwardly facing. Since Figure 4 of the Snedeker reference does not contain each and every limitation from Claim 13, the Snedeker reference does not anticipate Claim 13.

With regard to Claim 14, Figure 4 of the Snedeker reference does not teach or show that the terminating edge of the arcuate handle is substantially *facing rearwardly*. Clearly from figure 4, the terminating edge is substantially facing *upwardly*, and Claim 14 has the limitation of the terminating edge of the arcuate handle substantially facing *rearwardly*. Since, figure 4 of the Snedeker reference does contain each and every limitation from Claim 14; the Snedeker reference does not anticipate Claim 14.

Accordingly, based upon the foregoing express disclosure and teaching of the Snedeker reference, express claimed elements of the presently pending claims are clearly not present in the reference, and consequently, inappropriate as a basis for anticipation under 35 U.S.C. §102(b).

The Rennie Reference Does not Anticipate a Handleless Culinary Utensil Holding Food Objects and Limiting Spillage, a Terminating Edge Generally of the Generally Forwardly Curving Section, and a Terminating Edge of the Arcuate Handle Generally Forward Facing

With regard to Claim 9, the Rennie reference does not anticipate a *handleless culinary utensil holding food objects and limiting spillage*. The preamble of claim 9 states that the device is a handleless culinary utensil for holding food objects and limiting spillage. “Handleless” is defined by the specification as device that lacks protruding handle used to grip the device.

Appl. No. 10/136,001

Reply to Office Action of 11/30/2005

Attorney Docket No. : 6045-006

DRAFT

¶0010, lines 25-26. Handleless limits the structure of the claimed invention by requiring that the culinary utensil to lack a protruding handle; therefore, handleless must be treated as a claim limitation. Furthermore, a handleless culinary utensil holding food objects and limiting spillage is necessary to give life, meaning, and vitality to the claim, because the present invention is used for transporting food objects efficiently and good maneuverability around a *kitchen area* by virtue of a lack of protruding parts. ¶0008. Generally, a utensil is a "container used domestically, especially in the kitchen". See Merriam-Webster Dictionary at www.dictionary.com. The Rennie reference could not be used as a handleless culinary utensil, because it is a dust pan with handle D that protrudes from the disclosed device. See Figure 2. Furthermore, the Rennie device has a projecting lip with an edge that rests on the floor, which would be incapable of scooping up food objects due to incline nature of the projecting lip.

With regard to Claim 12, the Rennie reference does not show or teach a terminating end edge of the generally forwardly curving section. At best, the Rennie reference discloses opening *c* of the recess being substantially circular and continuous with lateral side walls *e*. In Figures 1 and 2, the disclosed dust pan shows that the upper curve *b'* does not have terminating edge, but the upper curve *b'* is continuous with lateral side walls. Since the Rennie reference does not show or teach all the limitations of Claim 12, the Rennie reference does not anticipate Claim 12.

With regard to Claim 13, the Rennie reference does not show or teach a terminating edge of the arcuate handle generally forwardly facing. The Rennie reference does not even disclose a terminating edge as noted above, and the Rennie reference discloses an opening *c* which is not forwardly facing. Since the Rennie reference does not show or teach all the limitations of Claim 13, the Rennie reference does not anticipate Claim 13.

Accordingly, based upon the foregoing express disclosure and teaching of the Rennie reference, express claimed elements of the presently pending claims are clearly not present in the reference, and consequently, inappropriate as a basis for anticipation under 35 U.S.C. §102(b).

The Snedeker Reference Does Not Render Claim 15 Obvious Because of the Handleless Culinary Utensil Holding Food Objects and Limiting Spillage Limitation

As noted above, the Snedeker reference does not contain each and every limitation of Claim 9; therefore, the Snedeker reference cannot render Claim 15 obvious. Claim 15 is a

Appl. No. 10/136,001

Reply to Office Action of 11/30/2005

Attorney Docket No. : 6045-006

DRAFT

dependent claim of Claim 9, so Claim 15 contains the limitation of the handleless culinary utensil holding food objects and limiting spillage. And since the Snedeker reference includes protruding handle 7 and is incapable of being used as a handleless culinary device, the Snedeker reference does not contain each and every limitation and does not render Claim 15 obvious.

Accordingly, express claimed elements of the presently pending claim are not present in the Snedeker reference. Applicant submits that Claim 15 are patentably distinct over the Snedeker Reference and requests the Examiner's favorable reconsideration of the §103(a) obviousness rejection based upon the Snedeker reference.

The Rennie Reference in light of the Brownell Reference Does Not Render Claim 15 Obvious Because of the Handleless Culinary Utensil Holding Food Objects and Limiting Spillage Limitation and the Brownell Reference is a Non-Analogous Art

As noted above, the Rennie reference does not contain each and every limitation of Claim 9; therefore, the Rennie reference cannot render Claim 15 obvious. Claim 15 is a dependent claim of Claim 9, so Claim 15 contains the limitation of the handleless culinary utensil holding food objects and limiting spillage. The Rennie reference could not be used as a handleless culinary utensil holding food objects and limiting spillage, because it is a dust pan with a protruding handle. Therefore, the Rennie reference does not contain each and every limitation and does not render Claim 15 obvious.

Furthermore, the Brownell reference is a non-analogous art, because it is not within the applicant's field of endeavor or reasonably pertinent to the particular problem with which the applicant is concerned. Applicant's field of endeavor is manipulating and transporting food objects for the purposes of food preparation and cooking. ¶0003. While the Brownell's field of endeavor is hand held portable devices such as trowels as related to cat-litter scoopers employed in the process of sifting out the contaminated debris. Col 1, Lines 6-8.

Additionally, the present invention was preliminary classified in the U.S. Class 220, pertaining to receptacles, while the Brownell reference is classified in U.S. Class 294, pertaining to hand and hoist-line implements. Moreover, there are significant structural differences between the current application and Brownell, i.e. transverse transitional-bend portions 36/36' and contaminant bowl area 12/12'. Therefore, Applicant respectfully submits that the Brownell

Appl. No. 10/136,001

Reply to Office Action of 11/30/2005

Attorney Docket No. : 6045-006

reference is in a non-analogous field of art, and therefore, inappropriate as a reference under 35 U.S.C. §103(a).

Accordingly, express claimed elements of the presently pending claim are not present in the Rennie reference and the Brownell reference is a non-analogous art; therefore Rennie in light of Brownell is inappropriate as a basis for obviousness under 35 U.S.C. 103(a).

Summary

Accordingly, Applicant submits that the pending claims are patentably distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited.

This Amendment Letter is being concurrently filed with a Transmittal Letter which includes a claim fee calculation and any applicable requests for extension of time which may be required for the proper presentation and consideration of the present amendments. While no additional fees other than those stated in the Transmittal Letter are believed to be required in connection with the filing of this amendment, the Director is hereby authorized to deduct any such fees from Deposit Account No. 18-2000 of which the undersigned is an authorized signatory.

Applicant solicits the Examiner's favorable reconsideration of the rejections and objections of record and submits that the presently pending claims are allowable over the art cited and of record, and therefore requests that Claims 9-18 be allowed. Should the Examiner find that there are any outstanding matters which are susceptible of resolution by telephone interview; the Examiner is invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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